REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 28, 2004. Claims 1-31 are pending in the present application. The Examiner rejects Claims 1-31. For the reasons described below, Applicants respectfully request reconsideration and allowance of Claims 1-31.

In the Specification

The Examiner objects to the specification as containing various informalities. Applicants have amended the specification as suggested by the Examiner. Therefore, reconsideration and favorable action are requested.

Claim Objections

The Examiner rejects Claims 21 and 31 because of certain informalities. Applicants have amended these claims as suggested by the Examiner. Therefore, reconsideration and favorable action are requested.

Section 103 Rejections

The Examiner rejects Claims 1-31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,128,759 issued to Hansen ("*Hansen*") in view of "Dynamic 3D Visualization of Database-Defined Tree Structures on the WWW by Using Rewriting Systems," by Noser et al. ("*Noser*"), and in further view of U.S. Patent No. 6,360,332 issued to Weinberg et al. ("*Weinberg*").

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained for at least two reasons. First, the Examiner has not provided sufficient evidence of a suggestion or motivation to combine *Hansen, Noser,* and/or *Weinberg*. Second, even assuming for the sake of argument that the references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Hansen, Noser,* and *Weinberg* whether

considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, still fail to disclose all of the elements of the pending claims.

A. **The Cited References Fail to Disclose, Teach, or Suggest Each and Every Element of Claims 1-31**

Hansen, Noser, and *Weinberg,* whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, fail to disclose each and every element of Claims 1-31.

Independent Claim 1 recites the following limitations:

A method for selecting members in a hierarchy, comprising:
determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members, the hierarchy of members being associated with a particular dimension of an organization of data;
recording the sequence of actions in a member selection script; and
executing the member selection script to select one or more members after the hierarchy of members has been modified.

Independent Claims 12 and 22 recite similar limitations. The combination of *Hansen, Noser,* and *Weinberg* fails to disclose each and every limitation of Claims 1, 12, and 22.

For example, the Examiner argues that *Hansen* discloses "determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members." Although *Hansen* discloses actions associated with leaves in a hierarchical tree structure (e.g., steps in a testing sequence arranged in a tree 301 in Figure 3A), *Hansen* does not disclose determining a sequence of actions that *collectively select one or members* from a hierarchy of members. The only "actions" in *Hansen* associated with any sort of tree (much less a member selection tree) are the testing actions that occur in a test sequence that are defined as the leaves in trees 301 and 330 in Figures 3A and 3B, respectively. These actions do not in any way involve selecting anything (including selecting one or more members from a hierarchy of members), but instead are actions involving the

testing of a device. Furthermore, there is no disclosure in *Hansen* of selecting particular test actions (leaves) from trees 301 or 330 to execute in a test sequence. Instead, it is the building of a tree itself that defines a test sequence, since all the test actions (leaves) in a tree are executed in the order as listed in the tree (*see* Col. 3, lines 63-67; Col. 6, line 66 – Col. 7, line 5; Col. 7, lines 52-59; Col. 15, lines 1-8; Figures 3A and 3B). There is no disclosure of the selection of particular leaves of the tree. Similarly, *Hansen* does not disclose a "sequence of actions in a *member selection script*" since there is not even a disclosure of determining a sequence of actions where the actions comprise "collectively selecting one or more members from a hierarchy of members," as recited in Claims 1, 12, and 22.

Furthermore, *Hansen* does not disclose executing a member selection script to select one or more members after a hierarchy of members has been modified. First, as described above, there is no disclosure of selection of members of a hierarchy or that a script is executed *to select* one or more such members. In addition, there is also no disclosure of executing such a member selection script to select members *after the hierarchy of members has been modified.*

Moreover, although the Examiner recognizes that *Hansen* does not disclose that the "hierarchy of members" in the first limitation of Claim 1 is associated with a particular dimension of an organization of data, the Examiner argues that *Noser* discloses this limitation. However, even assuming for the purposes of argument that *Noser* discloses a hierarchy of members being associated with a particular dimension of an organization of data, this is only one part of this first limitation. *Noser* does not disclose the other portion of this limitation – "determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members" – and the Examiner cannot simply split this limitation in the manner suggested. Furthermore, as described below, there is no suggestion or motivation to combine the unrelated teachings of *Hansen* and *Noser* to teach this entire limitation.

For at least these reasons, Applicants respectfully submit that Claims 1, 12, and 22, as well as the claims that depend from these independent claims, are in condition for allowance. Therefore, reconsideration and favorable action are respectfully requested.

Furthermore, in addition to being allowable as depending from an allowable independent claim, Claims 3, 14, and 24 are also allowable because none of the cited references discloses that "one or more of the actions comprise selecting the dimension from which members are to be selected." The Office Action states that these claims are rejected for the same reasons as given with respect to their parent claims; however, the Office Action does not describe where any of the cited references disclose selecting a dimension from which members are to be selected, much less that such a selection of a dimension is one of a sequence of one or more actions that collectively select one or more members from a hierarchy of members. For this additional reason, Applicants respectfully request reconsideration and allowance of Claims 3, 14, and 24.

B.   No Motivation or Suggestion to Combine *Hansen, Noser,* and *Weinberg*

Even assuming for the sake of argument that the cited references did disclose each and every limitation of Claims 1-31, there is no evidence of a suggestion or motivation to a person of ordinary skill in the art at the time of the invention to combine the references. The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. 2143.01. The "fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.[1] According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding." *In re*

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[1] Note M.P.E.P. 2145(X)(C) ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved. " *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

> Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).[2]

In the present case, the Examiner is improperly using the Applicant's disclosure as a blueprint for piecing together various elements of *Hansen, Noser,* and *Weinberg.* For example, there is simply no suggestion to combine *Hansen* and *Noser.* As alleged evidence of the desirability of combining *Hansen* and *Noser,* the Examiner cites the following passage from *Noser*:

> The designers of the Fusion system of Silicon Graphics [2] focus on the information landscape approach that is a natural cognitive paradigm for the users. This paradigm exploits spatial memory, landmarks, perspective, and neighborhood cues. In the information landscape model, 3D bar-charts are connected with each other via some topology on a landscape plane. A data block maps attributes of data into graphic attributes such as height, color, or text. A

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[2] *See also In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

cell contains data blocks and represents a particular relationship among these blocks. Connection lines represent contextual relationships between cells.

Specifically, the Examiner refers to the reference in this passage to "exploiting spatial memory, landmarks, perspective and neighborhood clues." Applicants do not see how this passage relates to either the "test environment" disclosed in *Hansen* or the invention claimed in the present application. More specifically, Applicants strongly disagree that this passage would make it obvious to one of ordinary skill in the art to modify *Hansen* with the teachings of *Noser* "for the purpose of exploiting spatial memory, landmarks, perspective and neighborhood cues," as stated by the Examiner. Applicants submit that there is simply no suggestion to modify the test environment disclosed in *Hansen* to somehow incorporate concepts associated with a hierarchy of members that is associated with a particular dimension of an organization of data, even assuming such concepts are taught in *Noser*. For example, there is no suggestion that 3D visualization of data would have any applicability to the test environment of *Hansen*. Thus, Applicants respectfully submit that the Examiner has failed to provide the suggestion or motivation required by M.P.E.P. § 2143.01. Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claims 1-31. For at least this additional reason, Applicant respectfully requests reconsideration and allowance of Claims 1-31.
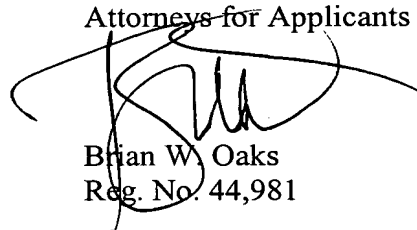
CONCLUSION

Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Applicants believe no fees are due; however, the Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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